

*Patent Application No. 09/874,478
Amendment dated January 5, 2003
Reply to Office Action of October 03, 2003
Docket No. 00/076 VDE*

REMARKS

Introduction

Status of claims

Claims 1 to 4 and 6 to 12 remain in this application. Claim 5 has been cancelled.

Claims 1, 6, and 10 have been currently amended.

Claim 1 has been amended by incorporating the subject matter of claim 5, which latter has then been cancelled. Likewise, the optional feature of the presence of hydroxyl group-containing polyurethanes **B13** has been cancelled in its second occurrence. Several amendments have been made to remove the ambiguity and the lack of clarity introduced by the poor translation. Likewise, the language used in the introductory part of the Markush groups has been adapted to the standard wording. As these amendments include only grammatical and linguistic corrections, the scope of the claims is not broadened, and no new matter is introduced.

Claim 6 has been amended by deleting the reference to claim 5 and by replacing the faulty expressions "molecular mass" and "above-average" by the correct terms "molar mass" and "number-average". Support for this amendment can be found at page 6, lines 18 and 19, of the specification. This error has apparently been introduced by the translators, as the priority document recites the correct term.

Claim 10 has been amended to introduce the correct wording for a "method of use" claim instead of

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the non-statutory wording. Basis for the amended claim can be found in page 8, lines 13 and 14, of the specification.

Accordingly, no new matter has been added by these amendments.

The Office Action

Claims 1 through 12 have been examined on the merits.

Rejection under 35 USC § 102 (b)

Claims 1 through 12 have been rejected under 35 USC § 102 (b) as being anticipated by Dickerhof et al., US 5,223,323.

This rejection is traversed for the reasons set forth below.

It is respectfully submitted that Dickerhof discloses aqueous coating compositions comprising melamine resins A, one or more polyols C, fillers E, and optionally, urea resins B and self-crosslinking polyacrylate aqueous dispersions D, but not the mixtures B1 of the organic amides B11 and of the polyhydroxyl compounds B12 which are claimed by amended claim 1. The presence of such mixtures as formaldehyde scavengers, or formaldehyde-binding additives, B, in the resin composition of claim 1 is mandatory per the amended claim 1.

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Therefore, the subject matter of the present invention is not anticipated by the Dickerhof reference, because while the polyhydroxyl compounds **B12** of the present invention correspond to the polyols **C** of Dickerhof, there is no mention of the combination or mixture of the organic amides **B11** having up to 10 carbon atoms and from one to four nitrogen atoms, and the polydroxyl compounds **B12**.

As is shown by the examples, on page 12, Table 1, the use of mixtures of polyhydroxyl compounds **B12** and organic amides **B11**, especially glycerol and urea which are used alone in comparative examples 2, 3, and 4, and in combination or mixture, as additive BA in examples 1 and 2, brings about a marked reduction in formaldehyde elimination both directly after preparation, as well as upon storage, even under the more critical tropical conditions (35 °C and 90 % relative humidity), compared with the effect of the constituents of the mixture alone. Such synergistic effect could not have been predicted from the use of the individual constituents of the mixture alone. Therefore, applicants deem that this effect proves the non-obviousness of the subject matter of the present invention.

For these reasons, it is believed that the subject matter as now claimed meets the requirements of patentability.

It is not believed that fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this paper, the fees are hereby authorized to be charged to Deposit Account No. 50-2193.

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Favourable reconsideration is therefore respectfully requested.

Respectfully submitted

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See attached Limited Recognition

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